

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. DICKINSON
and CHRISTOPHER P. RANDELL

Appeal No. 98-2326
Re Application 08/427,070¹

ON BRIEF

MAILED

AUG 20 1998¹

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before MCCANDLISH, Senior Administrative Patent Judge, and
ABRAMS and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally
rejecting claims 14-17 of this reissue application. Remaining
claims 1-13 have been allowed.

¹ Application for patent filed April 24, 1995. According to appellants,
this application is a Reissue of Application 07/855,116, filed March 18, 1992,
now Patent No. 5,207,224, issued May 4, 1993; which is a continuation of
Application 07/441,637, filed November 27, 1989.

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The claims on appeal are directed to a patient transport for an MRI system (claims 14 and 15), and to a method of positioning a patient for MRI (claims 16 and 17). The claims have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

LeVeen	4,230,129	Oct. 28, 1980
Matsutani	4,875,485	Oct. 24, 1989

THE REJECTION

Claims 14-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsutani in view of LaVeen.²

The rejection is explained in the Examiner's Answer and in the final rejection (Paper No. 7).

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

The Examiner's Rejection

According to the examiner, Matsutani teaches all of the subject matter recited in the claims except for the bed having

² A rejection under 35 U.S.C. § 112, second paragraph, was overcome by amendment (Paper No. 9).

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two supporting structures. However, it is the examiner's position that one of ordinary skill in the art would have found it obvious to modify the Matsutani system such that the patient bed is provided with two supports instead of the single support disclosed, in view of the teachings of LaVeen.

The appellants' point out they have "substantially exactly copied" some of the claims of U.S. Patent No. 5,395,749 to Li et al., and that Matsutani and LaVeen were available as prior art references when the search was performed for the claims of the Li et al. patent, but did not prevent the issuance of the Li et al. patent. Brief, pages 3-5. In other words, the appellants' position is that the rejection of the claims before us should not be sustained because they are very similar to claims of a U.S. Patent which was filed after the issuance of the two prior art references. The appellants have not pointed out any authority in support of this theory, and we know of none. Moreover, the fact that both the claim language and the references applied against them in the present case are different from the Li patent undermines the foundation of the argument.³ In any event, we are

³ Matsutani was cited as a reference of record in Li, while LaVeen was not.

not persuaded thereby that the rejection of claims 14-17 should not be sustained.

New Rejection Made By This Panel Of The Board

Pursuant to our authority under Rule 37 CFR § 1.196(b), we enter the following new rejection:

Claims 14-17 are rejected under 35 U.S.C. § 251 and, alternatively, under 35 U.S.C. § 112, first paragraph, as containing the following new matter not supported by the original disclosure of the patent upon which the reissue application is based.⁴

(1) The "spaced-apart structures . . . depending" from a horizontal patient bed, recited in claim 14, lines 6-8.

(2) The "opening . . . sized to pass said lower magnet pole therethrough," recited in claim 14, lines 8-9.

(3) The "aperture" in an undercarriage disposed below the bed, recited in claim 16, line 9.

(4) The step of "moving said bed . . . while moving said aperture . . . over a lower face of the magnet," recited in claim 16, lines 8-10).⁵

SUMMARY

The examiner's rejection of claims 14-17 is sustained.

⁴ New matter also appears in the specification (page 3, lines 38-39), and in the drawings (Figure 4).

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A new rejection of claims 14-17 has been entered by the Board.

The decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

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rejection to avoid termination of proceedings (37 CFR § 1.197(c))
as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .


Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.


If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED, 37 CFR § 1.196(b)


Harrison E. McCandlish, Senior)
Administrative Patent Judge)


Neal E. Abrams
Administrative Patent Judge


John P. McQuade
Administrative Patent Judge

BOARD OF PATENT
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